

REMARKS

This amendment responds to the Office Action mailed May 6, 2002. A one month extension of time is submitted herewith. Accordingly, Applicants respectfully submit that this response is being timely filed.

Claims 1-5 and 7-18 were pending. Claims 14-18 were canceled by this amendment without prejudice or disclaimer. New Claim 19 was added to this amendment. Accordingly, claims 1-5, 7-13 and 19 are now pending in the present application and, for the reasons set forth below, are believed to be in condition for allowance.

OBJECTIONS

The Office Action objects to Claims 1, 7, 10 and 14 because each claim has the limitation of "non-photoluminescent." In response, Claims 1, 7, and 10 have been amended to disclose "a material that is inert to light" as a positive limitation indicating that the material for the second portion is non-photoluminescent and not activated to glow by absorbing ambient light. It should be noted that the main reference cited by the Office Action, Glatz et al., uses the term "non-luminescent" in its claims.

REJECTION PURSUANT TO §112, ¶2:

The Office Action objects to Claims 14 and 17 for using the term "sufficient" as indefinite. Claims 14 and 17 have been canceled by this amendment without prejudice or disclaimer.

REJECTIONS PURSUANT TO §103

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REJECTIONS PURSUANT TO §103

The Office Action rejects Claims 1-5, 10 and 14-18 as being unpatentable over Glatz et al (5,904,017). In particular, the Office Action states that Glatz discloses, “a second extruded portion 210 (located between 212 and 214 in figure 2) coextruded with the first portion having a polyvinyl chloride strip positioned by the first portion to be disposed along the edge of the stair step” Office Action, p. 4. However, Claims 1-5 and 10 as amended disclose that the reflective second extruded portion is mounted on top of the first extruded portion, which is, in turn, mountable to the stair step. Conversely, Figure 2 of Glatz shows that the “second extruded portion 210” is mounted directly on the stair step and the “first extruded portion 216” is mounted on top of the second portion 210.

Moreover, the Office Action admits, “Glatz does not disclose expressly where the second portion has a material selected to have a reflectance factor greater than or equal to light gray polyvinyl chloride....” Office Action, p. 4. Instead, the Office Action states, “At the time the invention was made, it would have been obvious design choice to make the second portion from a material selected to have a reflectance factor greater than or equal to light gray polyvinyl chloride...” *Id.* However, the Glatz reference teaches away from making the second portion 210 from a reflective material because Glatz uses a photoluminescent strip 216 on the nose of the stair step to illuminate the step. Glatz, Figure 2. There is no motivation to make the portion 210 in Glatz from a

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reflective material. In fact, Glatz refers to the item with reference number 210 solely as a "tread." See Glatz, Col. 5, ll. 48-50.

Thus, based on the above amendments, Applicants respectfully traverse this rejection and request reconsideration.

The Office Action also rejects Claims 7-9 and 11-13 under 35 U.S.C. §103(a) as being unpatentable over Glatz et al (5,904,017) in view of George (6,116,748). In particular, the Office Action alleges that the lamp mounted on a seat in George combined with the photoluminescent device of Glatz discloses the present invention. However, the use of photoluminescent material in Glatz teaches directly away from the use of a light source in George.

As discussed above, the claims as amended call for use of a non-photoluminescent material. In the present invention, a strip of reflective material that is inert to light is preferably used. Accordingly, the two references do not identify each and every feature of the present invention and cannot support a *prima facie* case for obviousness. Reconsideration of this rejection is respectfully requested.

Additionally, the photoluminescent material of Glatz glows green-yellow. Glatz specifically discloses that photoluminescent material is used "to identify escape routes in the absence of light, such as during power outages" (Glatz, Col. 2, ll. 62-65) and is "for use in areas which become dark intermittently or during emergency situations." (Glatz, Col. 3, ll. 65-67.) Moreover, Glatz discourages the

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use of electrical systems due to, *inter alia*, expense and the need for a power source. (Glatz, Col. 1, ll. 31-35.)

In contrast, the lighting system for George is used for "continually illuminated aisles." (Col. 1, ll. 37-38.) There is no disclosure or suggestion in George regarding the use of photoluminescent material. Thus, Glatz teaches directly away from using a lamp as disclosed by George. Accordingly, Applicants respectfully traverse this rejection and request reconsideration thereof.

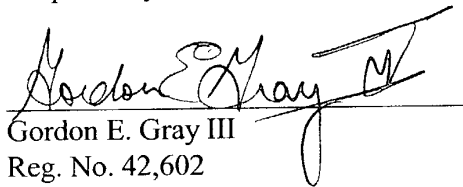
In both sets of § 103 rejections, the Office Action has assumed that making the tread 210 into a reflective strip is a mere design choice and therefore obvious. However, neither of the references cited, Glatz or George, discloses the use of a reflective strip. The only disclosure using a reflective strip is Applicants' disclosure. The Federal Circuit has advised against such reasoning, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Thus, a *prima facie* case of obviousness cannot be maintained and Applicants respectfully request reconsideration of these § 103 rejections.

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CONCLUSION

In each case, the pending rejections should be reconsidered in view of the amendments and remarks herein. Applicants believe that this case is in good condition for allowance, and a Notice of Allowance is earnestly solicited. If a telephone or further personal conference would be helpful, the Examiner is invited to call the undersigned, who will cooperate in any appropriate manner to advance prosecution.

Respectfully submitted,


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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

Please amend the "ABSTRACT" as follows:

ABSTRACT [OF THE DISCLOSURE]

A step lighting [fixture] apparatus comprising a coextrusion of a light reflective gray strip with a dark plastic body. The [reflective strip] apparatus is [located to lie at the edge] mountable to the nose of a stair step where the reflective strip is located at the edge of the step [and comprises a material which will reflect low level ambient light so as to provide a visible stripe indicating the step's edge]. The strip is made from a material that will reflect low level ambient light to indicate the step's edge.

IN THE CLAIMS:

Please cancel Claims 14-18 without prejudice or disclaimer. Please amend Claims 1, 7, and 10 as follows:

- 1 1. (Thrice Amended) A lighting apparatus comprising:
 - 2 a first extruded portion shaped to mount on the nose of a stair step; and,
 - 3 a second extruded portion coextruded with said first portion and
 - 4 mounted on top of the first portion so as to be above the nose of the stair step, said
 - 5 second portion comprising a [non-photoluminescent] material inert to light and
 - 6 selected to have a reflectance factor greater than or equal to light gray polyvinyl
 - 7 chloride.

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1 7. (Thrice Amended) A lighting apparatus mountable in connection with a
2 step of a staircase and comprising:

3 a first plastic extruded portion providing a step plate surface and a riser
4 surface mounted at a right angle with respect to one another and dimensioned to be
5 mounted on a nose portion of a stair step;

6 a second plastic [non-photoluminescent] light reflective strip made from
7 a material that is inert to light and coextruded with said first portion, [and] located so
8 as to be disposed at and visible along an edge of said step [in a darkened environment];
9 and,

10 a lamp mounted on a portion of a seat, said seat being located adjacent
11 to said step, where the lamp is positioned to cast light on the second plastic light
12 reflective strip for reflection by the strip.

1 10. (Twice Amended) A lighting apparatus comprising:

2 a first extruded portion shaped to mount on a nose of a stair step; and,

3 a second [non-photoluminescent reflective] strip portion coextruded with
4 said first portion from a reflective material inert to light; said strip mounted on top
5 of the first portion and located so as to be disposed at and visible along an edge of
6 said step in a darkened environment without connecting the strip to a power
7 source.

New Claim 19 was added by this amendment.

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